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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,054	03/28/2001	Adam R. Schran	10397-1U1	3079

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2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 04/21/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/820,054

Applicant(s)

SCHRAN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-5, 16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No. 5,826,242 issued to Montulli (hereafter Montulli).

Claims 1 and 16:

Montulli discloses:

- a) receiving at a server, a request from a subscriber to send a list of cookie file sources to the client machine [list of cookie file sources automatically sent from server to client, col 2, lines 28-37]
- b) downloading the list from the server to the client machine [col 8, lines 1-4, col 9, lines 18-36]
- c) using the downloaded list to detect cookie files received at the client machine from sources on the downloaded list [col 9, lines 53-63]

Claims 3 and 18:

Montulli discloses receiving updates of the downloaded list from the server on a periodic basis [col 9, lines 37-52].

Claims 4 and 19:

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Montulli discloses displaying the message at the client machine [col 7, lines 40- 43].

Claim 5:

Montulli discloses removing the detected cookie files from the client machine [col 8, lines 30-35].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2, 6-15, 17 and 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli in view of US Pat No 6,085,224 issued to Wagner (hereafter Wagner).

Claims 2, 15 and 21:

Montulli discloses the essential elements of claims 1, 12 and 16 as noted above.

Montulli fails to disclose a list of cookie files is not permitted to be stored.

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Wagner discloses a list of cookie files is not permitted to be stored [col 9, lines 45-55].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli include a list of cookie files is not permitted to be stored as taught by Wagner.

The ordinarily skilled artisan would have been motivated to modify Montulli per the above for the purpose of deleting cookies received from unauthorized clients provided by a server to prevent access to an undesirable website [col 9, line 46].

Claim 6:

Montulli discloses the elements of claim 1 as noted above.

Montulli fails to disclose preventing detected cookie files from being stored in the client machine.

Wagner discloses preventing detected cookie files from being stored in the client machine [col 9, lines 30-39].

Wagner discloses preventing detected cookie files from being stored in the client machine [col 9, lines 45-55].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli to include preventing detected cookie files from being stored in the client machine as taught by Wagner.

The ordinarily skilled artisan would have been motivated to modify Montulli per the above for the purpose of preventing the storing of cookies received from unauthorized clients provided by a server to prevent access to an undesirable website [col 9, line 46].

Claims 7 and 22:

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Montulli discloses a service provider master list of cookie file sources [list of cookie file sources automatically sent from server to client, col 2, lines 28-37], modifying the master list in accordance with the first and second exception list [col 8, lines 1-4, col 9, lines 18-36].

Montulli fails to disclose a first exception list of cookie files permitted to be stored, a second exception list of cookie files not permitted to be stored.

Wagner discloses a first exception list of cookie files permitted to be stored [col 9, lines 29-65], a second exception list of cookie files not permitted to be stored [col 9, lines 29-65].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli to include a first exception list of cookie files permitted to be stored, a second exception list of cookie files not permitted to be stored as taught by Wagner.

The ordinarily skilled artisan would have been motivated to modify Montulli per the above for the purpose of storing authorized cookies received from the server and preventing storing of unauthorized cookies received from the server to prevent access to an undesirable website [col 9, lines 29-65].

Claims 8 and 23:

The combination of Montulli and Wagner discloses the elements of claims 7 and 22 as noted above.

The combination of Montulli and Wagner discloses the composite list is stored in the client machine [col 9, lines 29-65].

Claims 9 and 24:

The combination of Montulli and Wagner discloses the elements of claims 7 and 22 as noted above.

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The combination of Montulli and Wagner discloses receiving updates of the downloaded list from the server on a periodic basis [Montulli, col 9, lines 37-52].

Claims 10 and 25:

The combination of Montulli and Wagner discloses the elements of claims 7 and 22 as noted above.

The combination of Montulli and Wagner discloses removing stored cookie files [Montulli, col 9, lines 33-36].

Claims 11 and 26:

The combination of Montulli and Wagner discloses the elements of claims 7 and 22 as noted above.

The combination of Montulli and Wagner discloses preventing cookie files from being stored in the client machine [Montulli, col 9, lines 33-36].

Claim 12:

Montulli discloses:

(a) receiving at the client machine, from a service provider, a master list of cookie file sources

[list of cookie file sources automatically sent from server to client, col 2, lines 28-37]

(b) deleting cookie file sources from the master list that correspond to one or more trusted cookie

file sources listed in the client machine [col 8, lines 30-35]

Montulli discloses the elements of claim 12 as noted above.

Montulli fails to disclose adding cookie file sources to the master list that correspond to one or more untrusted cookie file sources listed in the client machine, wherein the composite list

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is the master list as modified by any additions or deletions of trusted and untrusted cookie file sources.

Wagner discloses adding cookie file sources to the master list that correspond to one or more untrusted cookie file sources listed in the client machine, wherein the composite list is the master list as modified by any additions or deletions of trusted and untrusted cookie file sources [col 9, lines 29-65].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli to include adding cookie file sources to the master list that correspond to one or more untrusted cookie file sources listed in the client machine, wherein the composite list is the master list as modified by any additions or deletions of trusted and untrusted cookie file sources as taught by Wagner.

The ordinarily skilled artisan would have been motivated to modify Montulli per the above for the purpose of preventing the storing of unauthorized cookies to prevent access to an undesirable website [col 9, lines 29-65].

Claim 13:

The combination of Montulli and Wagner discloses the elements of claim 12 as noted above.

The combination of Montulli and Wagner discloses the master list and the composite list are stored independently in the client machine [Wagner, col 9, lines 29-65].

Claim 14:

The combination of Montulli and Wagner discloses the elements of claim 12 as noted above.

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The combination of Montulli and Wagner discloses removing cookie files stored in the client machine and received from sources on the composite list [Montulli, col 8, lines 30-35]

Claim 17:

The combination of Montulli and Wagner discloses the elements of claim 16 as noted above.

The combination of Montulli and Wagner discloses creating a first exception list including the identity of sources that are permitted to store cookie files in the client machine [Wagner, col 9, lines 29-65], creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine [Wagner col 9, lines 29-65] modifying the downloaded list in accordance with the first and second exception lists [Wagner, col 9, lines 29-65].

Claim 20:

The combination of Montulli and Wagner discloses the elements of claim 16 as noted above.

The combination of Montulli and Wagner discloses wherein computer-executable instructions perform a method comprising removing detected cookie files stored in the client machines [Montulli, col 8, lines 30-35]

Claim 27:

Montulli discloses:

(a) receiving at the client machine, from a service provide, a master list of cookie file sources [list of cookie file sources automatically sent from server to client, col 2, lines 28-37]

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(b) deleting cookie file sources from the master list that correspond to one or more trusted cookie file sources listed in the client machine [col 8, lines 30-35].

Montulli discloses the elements of claim 27 as noted above.

Montulli fails to disclose adding cookie file sources to the master list that correspond to one or more untrusted cookie file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of trusted and untrusted cookie file sources.

Wagner discloses adding cookie file sources to the master list that correspond to one or more untrusted cookie file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of trusted and untrusted cookie file sources [col 9, lines 29-65].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli to include adding cookie file sources to the master list that correspond to one or more untrusted cookie file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of trusted and untrusted cookie file sources as taught by Wagner.

The ordinarily skilled artisan would have been motivated to modify Montulli per the above for the purpose of controlling access to websites on the Internet.

Claim 28:

The combination of Montulli and Wagner discloses the elements of claim 27 as noted above.

The combination of Montulli and Wagner disclose wherein the master list and the composite list are stored independently in the client machine [Wagner, col 9, lines 29-65]

Claim 29:

The combination of Montulli and Wagner discloses the elements of claim 16 as noted above.

The combination of Montulli and Wagner disclose removing cookie files stored in the client machine and received from sources on the composite list [Montulli, col 8, lines 30-35].

Claim 30:

The combination of Montulli and Wagner discloses the elements of claim 27 as noted above.

The combination of Montulli and Wagner disclose preventing cookie files, received at the client machine from sources on the composite list, from being stored in the client machine [Wagner, col 9, lines 29-65].

Response to Arguments

Applicant's arguments filed 2/4/2004, have been considered but they are not fully persuasive.

First Applicant Argument:

Applicant states in the third paragraph on page 3 "Nowhere does Montulli describe creating cookie file sources (claim 1 step(a)), downloading cookie file lists (claim 1, step (b)), or using a downloaded list to detect cookie files (claim 1, step(c))."

First Examiner Response:

Examiner is not persuaded. Applicant states on page 3 that Montulli does not teach the limitations of claim 1. Examiner is perplexed as the disclosure of Montulli relevant to claim 1, is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Examiner maintains the following disclosure by Montulli, column 9, lines 53-63, reads on supra claim 1 limitations:

When a client system that implements the present invention wishes to send an http request to a particular Web server, the **client system first examines its cookie list** to see if the cookie list contains any matching cookies that need to be sent to the particular Web server. Specifically, before the client sends an http request to a Web server, the client compares the URL of the requested Web document against all of the stored cookies. If any of the cookies in the cookie list matches the requested URL then information containing the name/value pairs of the matching cookies will be sent along with the HTTP request.

Second Applicant Argument:

Applicant states in the first paragraph on page 5, "nowhere does Dutta disclose or suggest tracking cookie file sources (e.g. web sites) that are or are not permitted to store unmodifiable cookies in a client machine (claim 7, step (a) and (b)).

Second Examiner Response:

Examiner is not persuaded. Examiner maintains the following disclosure by Dutta in paragraph 6 reads on supra limitation:

Summary of Invention Paragraph:

[0006] FIG. 1 is a flow diagram of a process 100 illustrating how a typical browser operates. The user either selects a hyperlink in a Web browser or specifies a link in a browser, step 102. The client system examines its cookie list for matching cookies that need to be sent to the particular

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Web server, step 104. Specifically, before the client sends an HTTP request to a Web server, the client compares the URL of the requested Web document against all of the stored cookies. If any of the cookies in the cookie list matches the requested URL then information containing the name/value pairs of the matching cookies is sent along with the HTTP request, step 106. If there are no cookies that match the requested URL then the browser sends the request to the server, step 108. The browser receives the response from the server, step 110. The browser then looks for a cookie in the response from the server, step 112. Any cookies present in the response are stored on the hard drive of client machine, step 114 and the requested page is displayed, step 116. **In the event a cookie is not present in the response from the server**, the requested page is still displayed, step 116. This process is repeated with each hyperlink selected by the user, step 118. When no hyperlink is selected, the process stops, step 120.

Third Applicant Argument:

Applicant states in the first paragraph on page 5 “Nowhere does Dutta disclose or suggest tracking cookie file sources (e.g. web sites) that are or are not permitted to store unmodifiable cookies in a client machines (claim 7, steps (a) and (b)).

Third Examiner Response:

Examiner is persuaded. The rejection over Dutta has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

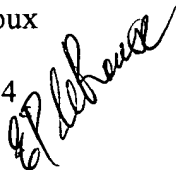
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

April 16, 2004

A handwritten signature in cursive script, appearing to read "Etienne LeRoux", written over the printed name and date.